

Hearing:  
July 23, 2003

This Opinion is Not  
Citable as  
Precedent of the  
TTAB

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Paper No. 60  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

Central Mfg. Inc.  
v.  
Astec Industries, Inc.

Opposition No. 91116821  
to application Serial No. 75564303  
filed on October 5, 1998

Central Mfg. Inc., pro se.

David J. Hill and Alicia Brown Oliver of Chambliss,  
Bahner & Stophel, P.C. for Astec Industries, Inc.

Before Walters, Bucher and Rogers,  
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Astec Industries, Inc. [applicant] has applied to register the mark STEALTH for goods identified as an "asphalt paving machine," in International Class 7. The application is based on applicant's allegations that it first used the mark "no later than April 30, 1998," first used the mark "in interstate commerce [in connection with

the goods] no later than August 31, 1998" and, as of the October 5, 1998 filing date, was using the mark in commerce through an wholly-owned subsidiary. After the mark was published for opposition, Central Mfg. Inc. [opposer] filed a notice of opposition.

The case was tried, although as will be discussed infra, this trial resulted in a thin record. The parties fully briefed the case, including in their briefs various motions. Oral arguments were presented.

***Construing the Pleadings***

The notice of opposition includes a preamble, numbered paragraphs and footnotes, all of which we have considered to be a part of the notice of opposition. Although we have liberally construed the notice of opposition, we note that it includes many allegations bearing no relation to legally cognizable bases for opposition and no references to any specific provisions of the Lanham Act.

We find opposer to have asserted that it uses the mark STEALTH as a "trade name, corporate name, service mark and trademark"; that opposer has used STEALTH as a trademark and trade name since 1981 and as a trademark for "rakes and shovels used for asphalt paving, since at

least as early as 1986";<sup>1</sup> and that its use of STEALTH as a mark for products or services in numerous classes of goods and services has been valid and continuous since 1981 and has not been abandoned.

Opposer also alleges that it "holds rights in" a number of "well-known STEALTH trademark registrations [and applications]" and that it has a "family" of STEALTH registrations.<sup>2</sup> In regard to the listed applications and registrations, opposer apparently is attempting to assert in paragraph 3 of the notice of opposition that it has attached to the pleading two copies of each registration and that it relies upon each registration.<sup>3</sup> No such

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<sup>1</sup> In paragraph 4 of the notice of opposition, opposer actually asserts "priority of use, as early as 1986, on the same and/or similar goods." However, the only goods specified in the notice appear in opposer's claim of use of STEALTH on or in connection with "rakes and shovels used for asphalt paving."

<sup>2</sup> In this regard paragraph 3 of the notice of opposition lists the mark and the registration number for seven registrations and 16 applications. Set forth in a table, are two columns of dates, so that two different dates are associated with each listed application or registration, and one column of mere numbers (e.g., 2, 6, 12, etc.). Opposer has not explained the significance of the dates or numbers in the table.

<sup>3</sup> Cryptically, paragraph 3 also asserts that the registrations "are incorporated herein by reference as if fully copied and attached." Incorporating a registration "by reference as if [but not actually] fully copied and attached" does not make the registration of record in the absence of some sort of admission by the defendant. Attachment of copies of registrations certified by the USPTO and showing current status and title would serve to make the registrations of record. As previously stated, no copies were made of record with the notice of opposition.

copies, however, were attached to the notice of opposition.

Opposer asserts that it has been "aggressive" in licensing its trademark and that applicant is aware of this.

We construe paragraph 5 of the opposition as asserting only a claim of likelihood of confusion, mistake or deception among consumers. The paragraph also asserts that use of STEALTH by applicant would "blur the distinctiveness" of opposer's "well known STEALTH trademarks." We do not view this phrase alone, contained as it is within a paragraph that alleges likelihood of confusion, mistake or deception, as alleging a claim of dilution. Opposer nowhere alleges that its mark is famous or when, if at all, it became famous; nor does opposer refer to the dilution section of the Lanham Act or even use the word dilution.

Paragraphs 8 through 11 of the notice are viewed as elaborating on opposer's view of why confusion will be likely and why opposer has standing to bring the opposition (e.g., asserted "loss of sales" by opposer and "damage" to opposer's licensing program).

Paragraph 12 asserts that applicant signed the involved application "with the knowledge that another

party had a right to use the mark in commerce."

Paragraph 24 is less comprehensible than paragraph 12; but it appears only to repeat the essential allegation of paragraph 12. Neither paragraph alone states a claim upon which relief can be granted; nor do the paragraphs considered together. Finally, though we have read each of these paragraphs in conjunction with other paragraphs, neither paragraph presents or is reasonably part of a legally cognizable claim.<sup>4</sup> Thus, we have given paragraphs 12 and 24 no consideration.

Similarly, we have given no consideration to paragraphs 13 and 14, which discuss a purported attempt by applicant to register a mark not involved herein, i.e., STEALTH FORCE, and opposer's asserted success in opposing that mark in another opposition proceeding. These paragraphs are not relevant to this proceeding and

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<sup>4</sup> Specifically, although the opposition includes allegations that applicant made certain deliberate misstatements in its application and that applicant intended the USPTO to rely on these statements, the allegations in paragraphs 12 and/or 24 do not constitute all or part of a fraud claim. Nowhere is there an allegation that applicant knew the right of another to be superior to applicant's right, so that the application could not have been filed in good faith; and mere knowledge of another's right to use the identical mark does not state a claim. Similarly, the allegations related to applicant's asserted knowledge of another's right and applicant's asserted knowledge of opposer's aggressive licensing program do not state a claim of fraud.

do not state any cognizable claim, either alone or with other paragraphs in the notice of opposition.

Likewise, we have not considered paragraphs 16 and 18, which assert that applicant's mark is a mere design which does not function as a mark and which is a functional configuration. This does not properly state a legally cognizable claim, either alone or with other paragraphs in the notice of opposition.

Paragraph 15 asserts that applicant's mark is descriptive or deceptively misdescriptive of applicant's paving machines. Having been properly pleaded, we have considered this claim.

Paragraph 17 asserts that applicant made no bona fide use of its mark in commerce prior to the filing of the application, so that the application is void ab initio.<sup>5</sup> However, we also view paragraph 17 as intended to be read in conjunction with paragraphs 20 and 21, so that, together, they present the first of three theories

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<sup>5</sup> We do not consider this construction of paragraph 17 as approval of opposer's attempt, during the proceeding, to amend its notice of opposition to assert that the application is void because it fails to state dates of use with requisite specificity, which would be a different claim. And a claim, we might add, that would be barred because the issue is an ex parte examination question. See *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989) ("fairness dictates that the ex parte question of the sufficiency of the specimens not be the basis for sustaining an opposition").

of fraud that opposer is asserting. Under the first theoretical fraud claim, opposer is asserting that applicant knew it had not made bona fide use in commerce and fraudulently induced the USPTO to rely on the statement of use in commerce to obtain approval of the mark for publication and eventual registration.

We also view opposer as asserting, in paragraph 22, that applicant's statement of its date of first use, as opposed to its date of first use in commerce, was known to be false and was part of an attempt to perpetrate a fraud on the USPTO. Finally, we view opposer as asserting its third theory for a fraud claim in paragraph 23. Specifically, opposer is asserting by this paragraph that the specimens of use submitted by applicant do not show the actual method of use of the mark by applicant, that applicant knew this and, notwithstanding such knowledge, made the statement to secure approval of its application.

Finally, opposer has asserted that applicant is not, and was not, at the time of filing of the application, the rightful owner of the mark.

As a result, we find opposer to have pleaded alternative claims under Section 2(d); a claim that STEALTH is descriptive or deceptively misdescriptive of

applicant's goods; a claim of lack of bona fide use in commerce prior to the filing date of the involved application; alternative claims of fraud; and a claim that applicant is not the rightful owner of the mark.

Applicant, in its answer, has admitted that it filed its application and that its mark was published for opposition. Applicant denied that opposer has used the mark STEALTH in interstate commerce in connection with paving machines "or in any other way that is likely to cause confusion with respect to [applicant's] use of its mark."

In regard to opposer's purported applications and registrations, applicant admits only that the applications have been filed and that the registrations "exist." Applicant denies "opposer is the applicant or owner of the registrations." As we also construe the answer liberally, we construe this paragraph in the answer as admitting that applications with the specified serial numbers are on file with the USPTO and that registrations with the specified registration numbers have issued, but we view applicant as having denied that opposer is owner of any of these, thus leaving opposer to prove its title in these registrations. We construe applicant's statement that "the registrations listed in



Paragraph 3 exist" as an admission that the seven pleaded registrations issued and have not been cancelled.

Applicant has otherwise denied, expressly or effectively, all other allegations in the notice of opposition. Titled as affirmative defenses are allegations by applicant that opposer has not pleaded fraud with particularity and that opposer's paragraphs 15 through 24 fail to state claims upon which relief can be granted. Finally, applicant asserts that paragraphs 15 through 24 of the notice of opposition violate Rule 11 of the Federal Rules of Civil Procedure.

Applicant asserted in its answer that if this Board did not dismiss the claims set forth by such paragraphs, applicant would pursue a separate motion for Rule 11 sanctions. Applicant did not, however, ever file a separate motion to dismiss any particular claims, or strike any particular claims, and did not file a Rule 11 motion regarding the contents of the notice of opposition. Therefore, the claims we have already discussed remain in this proceeding.

***Opposer's Motion to Amend Under Fed. R. Civ. P. 15(b)***

During the pendency of this proceeding, opposer made numerous attempts to amend its pleading. On more than

one occasion, it moved to amend its pleading "to conform to [the] evidence" notwithstanding that the parties had not yet gone through trial. Other motions to amend sought to expand the list of applications and registrations on which opposer could rely in this proceeding. Each of the motions, whether filed under Federal Rule 15(a) or Federal Rule 15(b), was denied as inappropriate and/or denied on its merits. Opposer, in its brief and reply brief, does not revisit any of these interlocutory rulings or seek reconsideration of those rulings. However, in its brief, opposer requests that the Board amend the notice of opposition to conform to the evidence, which we construe as a Rule 15(b) motion.

Opposer seeks to add "an abandonment claim and to deny registration to the Applicant based on the fact that the Applicant has presented no evidence of valid trademark use and thus [the] application should be denied based upon abandonment." Reply brief, p. 6; see also, opposer's main brief, pages 26-27. Applicant has argued against granting this motion, essentially asserting that the evidence does not support the motion because testimony from applicant's witness attests to applicant's continued use of the mark in commerce and that applicant has never abandoned the mark.

As applicant clearly has not consented to trial of an unpleaded claim of abandonment<sup>6</sup>, opposer must show that it has tried the claim with the implied consent of applicant. See Fed. R. Civ. P. 15(b); see also, authorities collected in TBMP §507.03(b) (2d ed. 2003).

We note that the only proffered evidence is opposer's single notice of reliance and applicant's single testimony deposition. We see nothing in the submissions made with the notice of reliance<sup>7</sup> or in opposer's cross-examination of applicant's witness<sup>8</sup>, that would suffice to put applicant on notice that opposer was pursuing a claim of abandonment, notwithstanding the irrelevance of such a claim (for reasons already noted). See *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984); *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883 (TTAB

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<sup>6</sup> Nor did applicant, by anything in its answer, assume the burden of proving prior and continuous use of its mark in commerce. Had applicant asserted, as an affirmative defense, that it had made use of STEALTH prior to opposer, then the abandonment claim opposer seeks to add might be relevant. Applicant did not, however, assert such a defense.

<sup>7</sup> At this point in our decision, we consider the notice of reliance only in regard to opposer's motion under Rule 15(b). We decide, *infra*, applicant's motion to strike many of the submissions made by that notice of reliance.

<sup>8</sup> As applicant has noted, on direct examination its witness testified that applicant has never abandoned its mark. On

1993). Accordingly, we deny opposer's motion under Federal Rule 15(b).

***Motions Relating to the Evidence***

What little evidence has been offered is the subject of various motions, which is not surprising for a case that appears to have featured much more involvement in procedural wrangling than in pursuit of the merits.

Applicant has moved to strike many of the submissions made with opposer's notice of reliance; and, in this regard, the parties do not simply debate the propriety of that request vis a vis the particular items proposed to be stricken, but also debate whether an interlocutory ruling on June 18, 2002 precludes consideration of applicant's motion.

Opposer has moved to strike the entirety of applicant's testimony deposition--an interesting prospect, because opposer relies on much of that testimony in its brief, in arguing for judgment on some of its pleaded claims.<sup>9</sup> Opposer asserts that the deposition was taken on insufficient notice. Opposer

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cross-examination, opposer did not inquire into or seek to undermine this testimony.

<sup>9</sup> In fact, in its reply brief, opposer argues that the testimony deposition should be stricken, "with the exception of Applicant's damning admission" regarding control of the quality of applicant's goods by its subsidiary.

also essentially moves, in the alternative, to strike exhibit 3 to the testimony, on the ground that it was not produced during discovery. Thus, we view opposer as asking us to strike applicant's testimony and exhibits in their entirety but, if we do not, to at least strike exhibit 3.

Applicant's Motion to Strike

First, we consider applicant's motion to strike portions of opposer's notice of reliance. A preliminary matter that must be considered is the parties' difference of opinion about whether the question of the admissibility of these items has already been ruled on in this case in the interlocutory order of June 18, 2002. After opposer filed its notice of reliance, applicant filed its objections to certain submissions made therewith. Opposer asserts that the Board's order of June 18, 2002 includes a denial of applicant's attempt to have the disputed items stricken. Applicant, on the other hand, views the order as directing applicant to raise its objections by a separate motion to strike; and applicant argues that it followed this instruction by including its motion to strike in its brief.

We have reviewed the disputed order and find the two sentences dealing with applicant's previously filed

objections to the notice of reliance to be confusing and inconclusive.<sup>10</sup> Moreover, because a panel at final hearing may not only review an interlocutory ruling but also may, if appropriate, reverse it, see *Harley-Davidson Motor Co. v. Pierce Foods Corp.*, 231 USPQ 857, 859 n.13 (TTAB 1986), we are not bound by either party's interpretation of the June 18, 2002 order, or the order itself.

By its motion to strike, applicant seeks to bar consideration of certain materials which it asserts cannot be made of record by notice of reliance. Moreover, for each of these items, applicant also has asserted substantive objections. When parties have procedural objections of a technical nature relative to a notice of reliance, they are encouraged to raise them promptly by a motion to strike. See TBMP §§532 and 707.02(b)(2)(2d ed. 2003). Substantive objections, however, may be reserved to final hearing and raised in a party's brief. In this case, applicant has done both,

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<sup>10</sup> The Board attorney simply noted the filing of the objections, that they were not "in the form of a motion to strike," and "decline[d] to so construe the objections." There was no instruction regarding whether the objections were being deferred for consideration at final hearing or whether they would have to be raised by motion to strike to be considered; and there was no instruction regarding when any such motion, if required, would have to be filed.

i.e., it has moved to strike and it has asserted substantive objections regarding the various subjects of its motion.

Because the holding of the interlocutory order is unclear, we have reconsidered the issues therein and we find applicant's filing of its motion to strike in its brief to meet the promptness requirement for procedural objections, e.g., whether a particular item may permissibly be made of record by notice of reliance. *Boyd's Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2019 (TTAB 2003). Moreover, even if we were to have found the interlocutory order to have had the effect of requiring applicant to file a motion to strike at an earlier point in the proceeding, applicant's failure to do so would not have prevented applicant from raising at final hearing any substantive objections to the material attached to opposer's notice of reliance. In other words, the probative value to be accorded evidence submitted by notice of reliance, and not excluded by grant of a motion to strike, may always be argued at final hearing.

Applicant seeks to strike exhibits A, C, H, I and J to opposer's notice of reliance.

Exhibit A to opposer's notice of reliance is a list of registrations and applications purportedly owned by opposer. First, we note that the list improperly includes many more registrations and applications than those listed in the notice of opposition. Further, a plaintiff relying on registrations cannot make those registrations of record by a list alone, even when, as with this notice of reliance, the list is referenced in a declaration<sup>11</sup> also accompanying the notice of reliance. See *Boyd's Collection*, supra, 65 USPQ2d at 2020 (TTAB 2003) (in the absence of a stipulation, parties may not present evidence by affidavit or declaration), and procedures described in TBMP §704.03(b). We agree with applicant that the list of opposer's purported registrations and the declaration referencing it are an inappropriate means for making pleaded registrations of record, and we have not considered this list.

Exhibit C is a copy only of opposer's second request for admissions by applicant, but not the responses

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<sup>11</sup> The declaration is signed by Leo Stoller, as president of Central Manufacturing Co., not Central Manufacturing Inc. While we choose in this instance to treat the difference in company names as an inadvertent discrepancy, and to assume that the declaration is from the president of opposer, opposer should not take this statement as indicating that there is no legal significance to the distinction.



thereto. Since applicant, in its motion to strike, clearly is arguing against opposer's attempt to introduce the responses, we construe the motion to strike to also target Exhibit E to opposer's notice of reliance, i.e., the responses to the requests that are contained in Exhibit C. Applicant argues that, insofar as its responses contained objections, opposer never sought to test the sufficiency or propriety of those objections and should not, therefore, be permitted to put the responses into the record. We disagree; the responses show that applicant admitted the authenticity of certain documents and objected to certain requests. Because the Trademark Rules allow introduction of responses to requests for admission by notice of reliance, and because applicant cites to no authority that requires objections to such requests to first be made the subject of a motion to test the sufficiency of the responses, we find no basis for seeking to strike the responses opposer has introduced. Accordingly, we have considered applicant's responses and objections to opposer's requests for admission.

Exhibits H and I are copies of opposer's responses to applicant's discovery requests. Applicant is entirely

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Also, although the declaration states that a copy of each listed registration is attached, plainly, no such copies were submitted.

correct that a party may not make its own discovery responses of record by notice of reliance, except in certain circumstances, none of which apply in this case. Therefore, these two exhibits have not been considered.

Finally, Exhibit J is a list of assertedly successful policing activities conducted by opposer to protect its assertedly registered marks. The previously referenced declaration by opposer's president also states "that Opposer's victories list is a true and correct copy." For the reasons outlined above in regard to the list of opposer's asserted registrations, we also find the "victories list" an inappropriate item for submission by notice of reliance, and we have not considered this exhibit.

In conclusion, applicant's motion to strike is granted as to exhibits A, H, I and J, and the declaration that refers thereto. These items are considered stricken from the record. The motion is denied as to Exhibit C and, to the extent the motion was also intended to cover Exhibit E, it is also denied as to that exhibit. These exhibits have been considered. We note, however, that even if we did not strike exhibits A, H, I and J, we would find applicant's substantive objections to the exhibits, on the grounds that they contain hearsay and

are unauthenticated, to be well taken. Thus, the exhibits would, in any event, be of little, if any, probative value.

Opposer's Motion to Strike

Prior to the commencement of its testimony period, applicant informed opposer of applicant's plan to take the testimony deposition of Jeff Richmond, and opposer acknowledged, by fax, receipt of the letter setting forth applicant's plan. In its acknowledgment, opposer informed applicant it would participate in the deposition by telephone. Next, approximately 10 days into the testimony period, on September 25, 2002, applicant forwarded, by both mail and fax, notice that the deposition would take place on October 7, 2002. Opposer, in arguing the unreasonableness of its actual notice, ignores the fax and focuses on its asserted receipt on October 1, 2002 of applicant's letter. Opposer does not, however, deny receipt of the fax. In arguing why the testimony should be stricken, opposer asserts "courts have consistently held" that 7 days notice of a deposition is insufficient, it being "normally considered that any notice under 15 days is inadequate notice." Opposer does not, however, cite to any authority for these statements.

Another argument raised by opposer is that, because this was a testimony deposition, rather than a discovery deposition, opposer needed more time to prepare. We take this argument as an attempt by opposer to show prejudice suffered because of the assertedly insufficient notice. In regard to this argument, we note that opposer, prior to the deposition, was presented with copies of the exhibits that applicant proposed to introduce through the testimony of its witness. There were only four exhibits. Further, being limited in its cross-examination to the scope of direct examination, and applicant having obtained scarcely two dozen pages of direct testimony, this clearly was a deposition that did not require extensive preparation by opposer.

We deny opposer's motion to strike the testimony deposition of Jeff Richmond for inadequate notice. Compare *Hamilton Burr Publishing Co. v. E.W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982) (Testimony considered despite only two days notice, because no significant travel involved to attend and no prejudice shown by objecting party) with *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1074 (TTAB 1990) (twenty-four hours notice held insufficient).

Having denied opposer's motion to strike the deposition in its entirety, we now consider opposer's alternative motion to strike applicant's exhibit 3 to the deposition. In essence, opposer is arguing for application of the estoppel sanction, discussed in TBMP §527.01(e) (2d ed. 2003) on the ground that the exhibit was not produced during discovery. We deny the motion. Applicant's failure to produce the exhibit during discovery was an oversight, now adequately explained by applicant's counsel. This is not a case where applicant refused to produce material so as to lead opposer to believe that it would not take testimony on a particular subject, specifically, applicant's first use. Cf. *Weiner King, Inc. v. Weiner King Corp.*, 615 F.2d 512, 204 USPQ 820 (CCPA 1980). Other exhibits to the Richmond testimony that were produced during discovery clearly allude to the first use. We note, however, that even if the motion were granted and the exhibit were not considered, it would not make any difference to the ultimate result herein, which, as discussed *infra*, is premised on opposer's failure to bear its burden of proof as to opposer's pleaded claims.

***The Merits of Opposer's Various Claims***

Earlier, we reviewed opposer's notice of opposition at length. Now, in conjunction with our consideration of what little evidence there is, we review the claims one by one.

Likelihood of Confusion

Opposer made a variety of factual assertions in connection with its claim, under Section 2(d), of likelihood of confusion among consumers. First, opposer has asserted that it owns various STEALTH registrations. Second, opposer has asserted that it has actually used STEALTH as a trademark in commerce for rakes and shovels used for asphalt paving, i.e., goods which opposer argues are complementary to applicant's paving machines. Third, opposer has asserted that it has a family of STEALTH marks.

The first of these Section 2(d) allegations fails because, although applicant has admitted that the seven pleaded registrations "exist," it specifically denied that opposer is the owner of them. In the face of this denial, opposer has not proved its ownership. Opposer, of course, attempted to do so by submitting a list of its asserted registrations with a declaration. We have

stricken those exhibits to the notice of reliance. We also note that, even had we not stricken those exhibits, and had we accepted the declaration and list as proof of applicant's ownership of the seven listed registrations that were also listed in the notice of opposition, we would find no likelihood of confusion because, though the involved marks are identical, the goods are vastly different.<sup>12</sup> In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973).

The second of opposer's Section 2(d) allegations fails because opposer has not established its use of the STEALTH mark on or in conjunction with rakes and shovels used for asphalt paving. Opposer did discuss its asserted use of the mark for these items in its responses to applicant's interrogatories, but we have stricken these as improper items to submit by opposer's own notice of reliance. Even if we had not stricken them, we would not give the interrogatory responses any significant

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<sup>12</sup> Applicant's goods are asphalt paving machines. The goods listed in opposer's seven pleaded registrations cover various sporting goods in class 28; bicycles, motorcycles and boats in class 12; microwave absorbing automobile paint in class 2; various items for playing pool or billiards, in class 28; comic books in class 16; lawn sprinklers in class 21; and metal alloys for use in sporting goods and transportation and window locks in class 6. Opposer has put in no evidence to show the relation of any of these items to asphalt paving machines, nor is any relationship apparent on its face.

probative value in the absence of any corroborating testimony or evidence, for a party's response to an interrogatory generally is viewed as "self-serving." *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 692 n.5 (TTAB 1977) *citing* *Grace & Co. v. City of Los Angeles*, 278 F.2d 771, 776 (9th Cir. 1960), and *Beecham Inc. v. Helene Curtis Industries, Inc.*, 189 USPQ 647 (TTAB 1976).

The third of the Section 2(d) allegations, i.e., opposer's claim that it has a family of marks, fails because it has not established the existence of the family or that it has promoted the members of the family in a way such that they would be recognized as a family. *Colony Foods, supra*, 222 USPQ at 186-87 (Fed. Cir. 1984).

Descriptiveness/Misdescriptiveness

As to opposer's claim that applicant's mark is descriptive or deceptively misdescriptive, opposer has not submitted any evidence to support the claim and did not pursue the claim in its brief. There appears to have been an attempt by opposer's president, during cross-examination of applicant's witness, to obtain an admission from the witness that STEALTH is descriptive of applicant's asphalt paving machine. We agree with



applicant's counsel, however, who objected during the deposition, that opposer was mischaracterizing the testimony, and that no such admission was made.

Bona Fide Use of Mark Prior to Filing Date

In regard to opposer's claim that applicant did not make bona fide use of the mark in commerce prior to its filing date, we find the testimony of applicant's witness to establish just the opposite. The testimony describes the first shipment of an asphalt paving machine bearing the mark and subsequent payment for the machine by the receiving party. The exhibits to the testimony corroborate the testimony. Opposer attempts to make much of the fact that the first shipment is not listed on the list of sales of STEALTH paving machines produced during discovery by applicant. However, the Richmond testimony explains that the shipment was made as of August 24, 1998 but the sale of this particular machine appears on the list of sales as of December 31, 1998, for accounting reasons, because that was when the final invoice issued. Because the application was not filed until October 5, 1998, the August 24, 1998 shipment was a bona fide use of the mark in commerce prior to the filing date of the application.

Fraud

As we have found that applicant made bona fide use of the mark in commerce prior to the filing date of the application, opposer's claim of fraud, based as it is on the lack of such use, also fails. Even if we had found that applicant's first shipment was not a bona fide use in commerce, we would still dismiss the related fraud claim, as opposer has not established that applicant intended to commit fraud on the USPTO.

Opposer's alternative fraud claim, specifically, that the date of first use asserted in the application, as opposed to the date of first use in commerce, is false and was known to applicant to be false, also must fail. Opposer has failed to submit any evidence to establish that the date asserted in the application is false, and has failed to prove that applicant intended to commit fraud on the USPTO. More importantly, the date of first use is not material to the office's examination of the application and decision whether to approve the mark for publication.

Opposer's additional alternative fraud claim, specifically, that applicant has not used the mark on the goods in the manner shown by the application specimens,

also fails for lack of proof. Opposer has offered no evidence whatsoever to support the claim.

Ownership

The only remaining claim is opposer's claim that applicant is not the owner of the mark. This is based on opposer's argument that Roadtec, a wholly-owned subsidiary of applicant Astec Industries, and a division of applicant, is the true owner of the mark and should have been listed in the application instead of Astec. Notwithstanding the evidence that indicates that Roadtec controls the quality of the STEALTH asphalt paving machine, there is nothing improper or unlawful about having a parent corporation apply to register a mark based on its subsidiary's use of the mark.

In sum, opposer has failed to prove any of its claims. Moreover, because opposer has not proved ownership of any of the pleaded registrations, or common law rights in STEALTH based on use for rakes and shovels, it has not established its standing to pursue the opposition. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1029 (Fed. Cir. 1999) (allegations alone do not establish standing and, if challenged, must be proved as part of the plaintiff's case). Accordingly, judgment is

entered against opposer on all claims and the opposition is dismissed.

***The Cross-Motions Under Federal Rule 11***

Though we have dismissed the opposition, we briefly address the parties' cross-motions under Rule 11 of the Federal Rules of Civil Procedure, for the sake of judicial efficiency. Applicant asserted in its brief that opposer had not proven its standing. Opposer took umbrage at the assertion and argued that applicant's arguments were sanctionable. In particular, opposer noted that it has been involved in numerous cases in the courts and before this Board and has never been held not to have standing.

Applicant responded to opposer's motion and filed a cross motion of its own, arguing that an improper motion under Rule 11 is itself sanctionable. In its response to opposer's initial motion, applicant noted that it could not know until after trial that opposer would not have proved its standing. Applicant also asserts that opposer has cited no authority for its initial Rule 11 motion targeting applicant's assertion, in its brief, that opposer failed to prove its standing. In support of its cross-motion, applicant argues that opposer has,

throughout the proceeding, caused needless delays; that Rule 11 is not to be bandied about as a tactical tool; and that opposer's motion is the last straw.

Opposer responded to applicant's cross-motion by filing a second Rule 11 motion, heaping another straw on the pile, so to speak. The arguments, however, are merely longer repetitions of those arguments in opposer's first motion. Opposer quotes at length from decisions (precedential and not) wherein opposer was found to have standing. Opposer apparently believes, mistakenly, that once it has been found to have standing in one case, it will always have standing for all cases. Opposer also appears not to have understood the difference between making sufficient allegations relating to standing in a pleading and, if challenged on those allegations, proving standing at trial as an element of one's case.

We do not find opposer's misunderstanding of the law to provide opposer with an excuse for filing not one but two Rule 11 motions. Applicant did nothing improper in arguing in its brief that opposer had not proved its pleaded allegations relating to standing. Likewise, applicant did nothing improper in cross-moving for Rule 11 sanctions after opposer refused to withdraw its first Rule 11 motion.

**Opposition No. 91/116,821**

We deny opposer's motions and grant applicant's cross-motion. Accordingly, we also enter judgment against opposer as a sanction for its abuse of the Rule 11 process.